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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/980,880
Filing Date: September 03, 2002
Appellant(s): GODA ET AL.

Lawrence E. Ashery
For Appellant

EXAMINER'S ANSWER

The Examiner's Answer dated 1/27/09 is vacated herewith.

This is in response to the appeal brief filed 11/26/08 appealing from the Office action mailed 9/2/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 5/17/07 has not been entered.

The amendment after final rejection filed on 12/5/05 has not been entered.

The amendment after final rejection filed on 10/24/05 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patent Abstracts of Japan No. 08-273649, 10-1996

Patent Abstracts of Japan No. 08-339785, 12-1996

6,019,802

Ichizuka et al.

2-2000

(9) Grounds of Rejection

The rejection under 35 U.S.C. 112, first paragraph has been withdrawn.

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-3, 5, 9, 10, and 12-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Abstracts of Japan No. 08-273649, hereinafter Onagawa in view of Patent Abstracts of Japan No. 08-339785, hereinafter Nishino.

Onagawa teaches a battery with a case, positive electrode, negative electrode, electrolyte, gasket sealing plate, a filter, a cap and a valve body, wherein said cap has a convex portion and a flange portion, and said filter has a bend portion, with caulk used as a sealant, wherein the valve body covers a hole in the filter portion and the filter and cap are in electrical communication with one another (abstract, paragraph [0006] and figure 1).

Onagawa does not teach that a projection or a plurality thereof is/are located at the outer periphery of said flange portion or what the shape of said projection is.

Nishino teaches providing a protrusion of concentrical circumference in an outer portion of said flange portion (figure 1, abstract and paragraphs [0007-0008]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include a protrusion in the outer periphery of the flange portion of the

sealing cap as taught by Nishino in the Onagawa reference in order to improve leakage resistance of the sealed battery. It would also be obvious to a person of ordinary skill in the art to provide a plurality of said protrusions since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onagawa in view of Nishino as applied to claims 1-3, 5, 9, 10, and 12-29 above, and further in view of U.S. Patent No. 6,019,802 herein after Ishizuka.

Onagawa also teaches gas holes in the cap (abstract, paragraph [0006] and figure 1).

Onagawa does not teach that the battery is cylindrical in shape.

Ishizuka teaches that a battery case is cylindrically shaped, which would inherently have a cylindrical opening especially since it receives a cylinder (column 22, lines 34-36).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to make the case for the battery in the Onagawa reference cylindrical as taught by Ishizuka in order to easily receive the battery cell which is rolled and to use a well-known industry standard to provide batteries that can be used in multiple applications because of the standardization.

(10) Response to Argument

Appellants state that proper consideration to claim limitations has not been given. Specifically the limitation of “a contact pressure of said first contact portion is stronger

than a contact pressure of said second contact portion". However said statement is inaccurate. Said limitation was addressed in the Final Office Action dated 9/2/05 in the Response to Arguments by stating that said limitation "is also given little to no patentable weight because it does not further limit the structure of the apparatus". Said limitation was further addressed in the Advisory Action dated 12/14/05 stating, "any sealant has infinite contact portions and because of the chemical nature of all sealants it is inherent that there will be weak and strong contact portions".

It should also be noted that there is no recitation in claim 1, stating where specifically the first and second contact portions are located with respect to each other.

As recited in the claims a "caulked portion includes a first contact portion and a second contact portion between the surface of the outer periphery end of said flange and said bend portion, a contact pressure of said first contact portion is stronger than a contact pressure of said second contact portion", said recitation does not define the supposed locations of the two different portions and there is no other definition in the claims or the specification defining what makes the strong contact portion and what makes the weak contact portion. The Examiner stated in the Final Office Action dated 9/2/05 that those supposed portions do not define structurally over the prior art. The prior art that has been applied has substantially similar structure to the instant claims and therefore as combined it will inherently have at least two different contact portions having two different strengths because all seals including caulk will chemically form a better seal in some areas versus others especially when curing and other factors of how the seals are set are considered. This inherent property as explained above will exist in

all of the instant claims that recite any sort of contact pressure being stronger than another in the caulk such as independent claims 12, 14, 16 and 23.

When comparing the two prior art references appellants state that the entire reference must be considered and have compared the intended use of both prior art inventions. However the Examiner is relying on the conceptual teaching of a protrusion taught by Nishino as part of the outer periphery of the flange portion of the battery cap, which is clearly seen in figure 4 and labeled as 1a. Nishino states that the purpose of adding this protrusion is to improve the fluid leakage resistance of a sealed battery. Onagawa teaches a sealed battery that has all of the features of the instant invention except for the protrusion located at the outer periphery of the flange portion of the battery cap. Therefore it is the Examiner's position that by adding the conceptual feature of a protrusion to the outer periphery of the flange portion of the battery cap, this will improve the fluid leakage resistance of the sealed battery of Onagawa as taught by Nishino, especially since this is the purpose of Nishino. Nowhere did the Examiner ever state that he is taking the cap and gasket of Nishino and providing it in Onagawa as appellants suggest on page 12, first full paragraph.

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. Therefore it is not hindsight reasoning for the Examiner to take an expressed teaching from the prior art of improving fluid leakage resistance in a sealed battery and use said teaching as motivation for combining with another prior art reference. Regardless of whether or not appellants are doing the same thing for the same reason.

Appellants also argue that the strong contact portion forms around the projection. It is also the position of the Examiner that the invention of Onagawa as modified by Nishino will also inherently have a strong contact portion formed around the protrusion especially since there will be a spring action against the protrusion when the cap is pressed in place.

It should also be noted that in light of the recent Supreme Court decision KSR v. Teleflex, under Rationale C, if a technique has been used to improve one device (adding a protrusion into the seal of a battery), and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way (to improve fluid leakage of a battery), using the technique is obvious unless its actual application is beyond his or her skill.

With regards to the rejections of claims 1-29 under 35 U.S.C. 112, first paragraph, although the limitations in the claims are not literally supported by the specification, the specification does infer that the contact portions will have different contact pressures. Therefore the rejection was withdrawn as was also discussed in the Pre-Appeal Conference.

Therefore the Examiner has met his burden and has in fact addressed every claim limitation with regards to the prior art and has also made a clear *prima facie* case of combining references and showing obvious modifications with motivation for modifying within the teachings of the prior art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Robert Hodge/

Examiner, Art Unit 1795

Conferees:

/Michael Barr/

Supervisory Patent Examiner, Art Unit 1792

Roy King

/Roy King/

Supervisory Patent Examiner, Art Unit 1793